Supreme Court, U.S.
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No. _____

IN THE

Supreme Court of the United States

INFINITE PICTURES, INC.
Petitioner,

v.

INTERACTIVE PICTURES CORPORATION
(formerly known as Omniview, Inc.)
Respondent.

Petition for Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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June 10, 2002

QUESTION PRESENTED

Whether the judicial doctrine of equivalents can be used to circumvent the limits on patent claim breadth mandated by Congress in 35 U.S.C. §112, ¶ 6.

PARTIES TO THE PROCEEDING AND RULE 29.6 STATEMENT

Petitioner Infinite Pictures, nka iMove, Inc., and Respondent Interactive Pictures, fka Omniview, Inc., nka Internet Pictures Corp., are the only parties to this proceeding.

Infinite Pictures, nka iMove, Inc., is not a publicly-held company and has no parent company.

Interactive Pictures, fka Omniview, Inc., nka Internet Pictures Corp., is a publicly-held company and has no parent company.

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INTERACTIVE PICTURES CORPORATION
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Respondent.

Petition for a Writ of Certiorari to the
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PETITION FOR A WRIT OF CERTIORARI

Petitioner request a writ of certiorari to resolve a conflict between the judicially-created doctrine of equivalents and the congressionally-mandated equivalents analysis for functionally-claimed elements (expressed in 35 U.S.C. § 112, ¶ 6). This Court has never before addressed the issue of whether the doctrine of equivalents can override the statutory construction analysis of § 112(6) for functional claim elements.

Decisions of this Court that have addressed the doctrine of equivalents have dealt with claim elements that recite the invention in terms of structure or material (what it is) rather than in terms of its function (what it does). *See, e.g., Festo Corp. v.*

Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. ___ (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997); *Graver Tank & Mfg. Co. v. The Linde Air Products Co.*, 339 U.S. 605, 85 USPQ 328 (1950).

The only decision of this Court dealing with a functional claim element is *Halliburton Oil Well Cementing Co. v. Walker et al.*, 329 U.S. 1 (1946), which held, in essence, that patent claims defining an element solely by its function are too broad and ambiguous to be valid. *See id.* at 8. In 1952, Congress enacted the last paragraph of 35 U.S.C. § 112 (now paragraph six) in response to this Court's holding in *Halliburton*.

To overcome the concerns expressed by this Court, the statute strikes a balance that permits functionally-stated claim elements while ensuring compliance with both the public notice and definiteness requirements of patent claiming. To do this, the statute commands that functionally-claimed elements "*shall be construed* to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112, ¶ 6 (emphasis added). The statute includes a built-in equivalents provision.

Left unchecked, the decision below will destroy the balance struck by Congress. It will permit application of the judicial equivalents doctrine to functionally-claimed elements in a way that eviscerates the statutory claim construction guidelines of § 112(6).

The Court must hear this case to decide whether the judge-made doctrine of equivalents can apply to congressionally-restricted functional claim elements—given the nature of, and history behind, the statutory provision authorizing such claim elements. If the doctrine of equivalents can be applied to §112(6) claim elements, the Court must provide guidance to ensure that the judicial doctrine does not vitiate the statutory

mandate. Otherwise, patentees will routinely strive to bypass §112(6) by resort to the doctrine of equivalents.

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a) is reported at 274 F.3d 1371, 61 USPQ2d 1152. The opinions, orders, and judgment of the district court (Pet. App. 31a) are not reported.

JURISDICTION

The judgment of the court of appeals was entered on December 20, 2001. Petitioner's request for rehearing *en banc* was denied on March 21, 2002. [Pet. App. 48a]. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 112, ¶ 6 provides:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claims shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

[Pet. App. 54a].

STATEMENT OF THE CASE

A. The Patent at Issue

Claim 1 of U.S. Patent No. 5,185,667 (the '667 patent) is the only independent claim at issue. [1] This

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[1] Claim 1 reads as follows:

1. A device for providing perspective corrected views of a selected portion of a hemispherical view in a desired format that utilizes no moving parts, which comprises:

a camera imaging system for receiving optical images and for producing output signals corresponding to said optical images;

fisheye lens means attached to said camera imaging system for producing said optical images, throughout said hemispherical field-of-view, for optical conveyance to said camera imaging system;

image capture means for receiving said output signals from said camera imaging system and for digitizing said output signals from said camera imaging system;

input image memory means for receiving said digitized signals;

image transform processor means for processing said digitized signals in said input image memory means according to selected viewing angles and magnification, and for producing output transform calculation signals according to a combination of said digitized signals, said selected viewing angles and said selected magnification;

output image memory means for receiving said output signals from said image transform processor means;

input means for selecting said viewing angles and magnification;

microprocessor means for receiving said selected viewing angles and magnification from said input means and for converting said selected viewing angles and magnification for input to said

apparatus claim is directed to a device for capturing a hemispherical fisheye optical image, digitizing the image, and then transforming and magnifying a selected portion of that image to produce a perspective corrected view. The claimed device includes a camera imaging system with a fisheye lens coupled to a series of elements that capture, digitize, and store the hemispherical fisheye image from the camera and then transform the digitized fisheye image into a perspective corrected view based on selected viewing angles and magnification.

A key element of this claim is the "image transform processor means" described in the specification as providing "direct mapping of the hemispherical image region of interest into a corrected image using an orthogonal set of transformation algorithms." The '667 patent, col. 2, lines 51-54.[2]

B. District Court Proceedings

Before trial, Respondent conceded the lack of literal infringement of claim 1 based on non-identity of functions performed with respect to the "image transform processor means" element. In particular, the accused software did not process "said digitized [fisheye] images" as required by the claims. Respondent's entire case for infringement rested, instead, on the doctrine of equivalents. In particular, Respondent contended that an equirectangular

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image transform processor means to control said processing of said transform processor means; and

output means connected to said output image memory means for recording said perspective corrected view according to said selected viewing angles and magnification.

[2] One of "[t]he keys to the success of the invention [is that] the entire input image need not be transformed, only the portion of interest." The '667 patent, col. 4, lines 16-19.

panorama of the accused device, though not an image obtained directly from a fisheye lens camera as required by the claim, was interchangeable with such an image[3] and that the transform means function was therefore substantially the same.

The testimony on interchangeability at trial only related to equivalence between the claimed function and the function performed in the accused device. It does not equate the structures [i.e., computer algorithms] for performing those "equivalent" functions. The district court used an expansive claim construction, made without regard to the construction procedure mandated by §112[6]. This construction permitted a finding of infringement despite the complete absence of evidence on structural equivalence. This error in claim construction is evident, in particular, from the jury instruction construing the critical "image transform processor means" limitation:

> The fifth element, image transform processor means, *refers to the computer software by which the user's selected viewing angles and magnification and the digitized signals corresponding to a photographed image are processed* so as *to produce* the output transform calculation signals which provide *the perspective corrected view*, including his or her selected viewing angles and magnification, which the user wishes to view.
>
> (emphasis added)

The district court, in effect, applied the doctrine of equivalents in construing this element, rather than the statutory construction rules of §112(6). This

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[3] The relationship between an equirectangular image and a hemispherical fisheye image resembles the relationship between a Mercator map and a globe map.

broad instruction decoupled the means-plus-function element from the recited functions [i.e., processing digitized fisheye signals and producing output signals by combining the digitized fisheye signals with the selected viewing angles and magnification], and from the disclosed structure (i.e., the orthogonal set of transform algorithms disclosed for accomplishing the recited function).[4] The trial court's claim construction expanded the scope of this element to cover any software resulting in a perspective corrected view. Following this instruction (broad enough to support even a finding of literal infringement), the jury found infringement under the doctrine of equivalents. The district court denied JMOL based on the same claim construction.

C. Court of Appeals Decision

The Federal Circuit upheld the district court's claim construction and the jury's finding of infringement under the doctrine of equivalents without requiring any evidence regarding the structures used to perform the functions at issue. In particular, although "the structure of a microprocessor programmed to carry out an algorithm is limited by the disclosed algorithm," *WMS Gaming, Inc. v. Int'l Gaming Tech.*, 184 F.3d 1339, 1348, 51 USPQ2d 1385 (Fed. Cir. 1999), no effort was made to identify or compare algorithms.

The sole evidence cited by the Federal Circuit as supporting the finding of infringement relates, at most, to functional equivalence:

> We agree that substantial evidence supports the finding of equivalence. Although Infinite attacks Birdwell's testimony as being

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[4] Compare this instruction to the actual claim language for the "image transform processor means" element as set forth in footnote 1.

> conclusory, the testimony is more than that. Birdwell showed the jury both a fisheye image and an image in an equirectangular panorama format, while testifying that one can be derived from the other. He also explained that perspective-correction processing of one of the two image forms is substantially the same as that of the other, and he illustrated the similarity with reference to Infinite's own block diagrams of the processing steps.
>
> [Pet. App. 23a]

The processing blocks shown in the block diagrams, however, merely represent the functions performed, not the algorithms used to perform those functions. *See* PX – 308 at Pet. App. 56a.

The Federal Circuit decision permitted application of the doctrine of equivalents to a means-plus-function element, implicitly rejecting Petitioner's argument that resort to the doctrine of equivalents for this functional element short-circuited the §112(6) statutory analysis. Moreover, the Federal Circuit upheld the finding of infringement without requiring a construction of the claim under §112(6).

The Federal Circuit's holding improperly relieved the Respondent of the burden of showing structural equivalence separate and apart from functional equivalence. Because no evidence was presented regarding the algorithms of the accused device, and because no attempt was made to identify or equate the algorithms used to perform the allegedly equivalent functions, structural equivalency lacks any support in the record.

The Federal Circuit also failed to follow the "all elements" or "all limitations" rule endorsed in *Warner-Jenkinson* in at least two ways. First, the Federal Circuit permitted a claim construction that entirely

vitiated the recited function. *See Warner-Jenkinson*, 520 U.S. at 29, 40. In particular, the Federal Circuit did not require the transformation to be performed "according to the combination" of signals explicitly recited in the claim, as required in *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987) (*en banc*). Second, the Court failed to consider the relationship of the functionally-claimed element to the claim as a whole. *See Warner-Jenkinson*, 520 U.S. at 40. Specifically, Respondent's permitted substitution of the "equirectangular panorama signals" for the "digitized [fisheye] signals" failed to take into account the use of the "digitized [fisheye] signals" in the context of the claim as a whole. [5] This substitution, despite the fact that it left the substituted claim element without connection to the remainder of the claim, was permitted to form the entire basis for the conclusion of equivalency.

Replacing the digitized fisheye signals with the equirectangular panorama signals represented much more than an insubstantial change in both the function and the structure of the claimed device.

REASONS FOR GRANTING THE PETITION

This case presents an unparalleled opportunity to resolve important and fundamental questions of patent law, namely—whether the doctrine of equivalents can apply to a §112(6) claim element, and if so, whether it can apply in a way that bypasses the statutory construction requirements of §112(6), such

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[5] This substitution precludes direct transformation of a selected view of an input fisheye image into the output image as explicitly called for by the claim language. It is also contrary to the "keys" to the success of the invention because it *requires* transformation of the entire input fisheye image into an equirectangular panorama image.

as by ignoring the disclosed structure or by vitiating a recited function.

I. The Doctrine of Equivalents Should not Apply to Elements Written in Functional Form

A. Congress's Mandate to Apply the Statutory Construction Guidelines of §112(6) Precludes Further Judicial Expansion

Application of the doctrine of equivalents to §112(6) claim elements abrogates the statutory claim construction requirements and violates the public-notice and definitional requirements of patent claiming. In *Halliburton*, this Court held that patent claims defining an element solely by its function are too broad and ambiguous to be valid. *See id.*, 329 U.S. at 8.

In response, Congress enacted the last paragraph of §112 to permit a claim to a combination to include an element expressed as a "means" or "step" for performing a function. The statute commands, however, that such a claim "*shall be construed* to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112, ¶ 6 (emphasis added). In light of the congressional enactment of an equivalents provision for construing functionally-claimed elements, the judicial doctrine of equivalents should not be permitted to circumvent the statutory interpretation guidelines for those elements.

There is no constitutional or logical support for superimposing the doctrine of equivalents over the construction mandated for functional claim elements by §112(6). Congress has the controlling authority to legislate on patent matters under Article I, § 8, cl. 8 of the Constitution. Congress has exercised that power through §112(6) – the only provision in the patent statute directing a claim construction methodology.

It makes no sense to overlay the judicial doctrine of equivalents on a §112(6) claim element because Congress has already built equivalents into §112(6). Congress expressly and deliberately limited that "equivalents" analysis to equivalent structures, materials or acts, to remove the indefiniteness of functional claims noted by this Court in *Halliburton*. Accordingly, it is not for the courts to broaden that analysis by layering the judicial doctrine of equivalents over top of the statutory construction framework, or by bypassing §112(6) altogether.

B. Reconciling Decisions of this Court with the Enactment of §112(6) Dictates that Application of the Doctrine of Equivalents to Functionally-claimed Elements Should be Precluded

Although the doctrine of equivalents has been upheld by this Court, none of this Court's cases has addressed whether the judicial equivalents doctrine can apply to already statutorily-broadened §112(6) elements. Claim construction concerns are different when dealing with functional claim language as opposed to structural claim language.

In *Graver Tank & Mfg. Co. v. The Linde Air Products Co.*, 339 U.S. 605, 85 USPQ 328 (1950), for example, this Court did not deal with a means-plus-function element, but dealt, rather, with substitution of one material in a welding flux for another recited in the claim. Indeed, coming close behind *Halliburton*, and before the 1952 Act, a functional claim element was not then even valid.

In *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997), the Court concluded that the enactment of §112(6) did not replace the doctrine of equivalents. However, the Court did not address the relationship between the two "equivalents" approaches when both forms of

equivalents are implicated.[6] *See* 520 U.S. at 28. The Court expressed concern, moreover, that the doctrine has become "unbounded by the patent claims." *Id.* at 28-29. The Court further confirmed the "all elements" rule and cautioned that "[i]t is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety." *Id.* at 29.

Similarly, in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. ___ (2002), this Court recently reaffirmed the vitality of the doctrine of equivalents with respect to claim elements stated in terms of structure or material,[7] but did not address the implications with respect to functionally-claimed elements. *See id.* The Court in *Festo* emphasized, however, the role of Congress in establishing rules for the interpretation of patent claims. *See id.*, slip op. at 14. When Congress chooses to impose construction guidelines for specific claim elements, therefore, lower courts should not be permitted to disrupt or ignore those guidelines through the loose application of judicial doctrines.

Applying the doctrine of equivalents to functional claim elements, as in this case, essentially eviscerates the 1952 congressional enactment of §112(6), recreating the ambiguity condemned by this Court in *Halliburton*. *Halliburton* remains authority for the position that a functional claim element, unbounded by the statutory requirements of §112(6), is invalid. The validity of such an element can only be sustained

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[6] In *Warner-Jenkinson*, the claim element at issue dealt with a range of pH, and was not a functional claim element.

[7] The elements at issue in *Festo* were a pair of one-way sealing rings and a magnetizable outer sleeve material for an industrial device.

by giving full effect to the claim construction mandate of the statute. And that mandate cannot be carried out if the doctrine of equivalents is permitted to expand already broad functional claim language by supplementing or replacing the built-in equivalents analysis in §112(6).

C. There is Doubt Among Judges at the Federal Circuit Regarding Whether the Doctrine of Equivalents Can Apply to §112(6) Claim Elements

In *Dawn Equipment Co. v. Kentucky Farms Inc.*, 140 F.3d 1009, 46 USPQ2d 1109 (Fed. Cir. 1998), two Federal Circuit judges each set forth additional views questioning the applicability of the doctrine of equivalence to §112(6) claim elements. *See id.*, 140 F.3d at 1018-22 (opinion of Plager, J.), 1023 (opinion of Michel, J.). In his separate views, Judge Michel queried whether "affording the patentee additional protection under the doctrine of equivalents conflicts with the very language and intent of 35 U.S.C. §112(6) (1994), which covers only those 'equivalents' disclosed in the specification." *Id.* at 1023. After reminding the reader of this Court's emphasis on the critical notice function of patent claims, and explaining that the need for notice is all the greater in the case of means-plus-function limitations, Judge Michel further asked:

> Is it contrary to §112(6) to expand the protection for inventions claimed partly in means-plus-function format by also applying the doctrine of equivalents to limitations claimed in that format, when protection for some but not all equivalents has already been incorporated into the statute itself and when doing so further diminishes the notice function of the patent?

Id. at 1023. This Court should expressly answer these questions.

II. If Applicable to Functional Claim Elements, the Doctrine Of Equivalents Cannot be Untethered from the Claim's Literal Construction Under 35 U.S.C. § 112, ¶ 6.

A. Public Notice Requires that Functional Claim Elements be Constrained by §112(6).

Congress requires that patent claims be written in a way that clearly defines the scope of the claimed subject matter. *See* 35 U.S.C. § 112, ¶ 2. This Court and the Federal Circuit have each recognized that expansive application of the judicially-created doctrine of equivalents "conflicts with the definitional and public-notice functions of the statutory claiming requirement." *Warner-Jenkinson*, 520 U.S. at 29; *see also Sage Products, Inc. v. Devon Indus., Inc.*, 126 F.3d 1420,1424, 44 USPQ2d 1103 (Fed. Cir. 1997) ("Applied . . . broadly, the doctrine [conflicts] with the primacy of the claims in defining the scope of a patentee's exclusive rights.").

When the statutory equivalents provision and the doctrine of equivalents are both implicated, the need for curtailing undue expansion of the claim language is even more pressing. "[S]ection 112, paragraph 6, rules out the possibility that any and every means which performs the function specified in the claim *literally* satisfies that limitation." *Pennwalt*, 833 F.2d at 934. The doctrine of equivalents should not permit what the statute was specifically designed to prevent.

A doctrine of equivalents analysis of a means-plus-function element, if permitted at all, must not be untethered from its statutorily-mandated claim construction, either by forsaking an analysis of its structural limits or by permitting the doctrine to vitiate a required function.

The Federal Circuit in this case, however, permitted application of the doctrine of equivalents to an already statutorily-broadened claim element in a manner which both ignored the structural limitations imposed on the claim by §112(6) and vitiated the function explicitly required by the claim.

B. The Decision Below Permits an Infringement Finding Regarding a Functional Claim Element Without a Proper §112(6) Structural Equivalents Analysis

For microprocessor and computer elements, the structure is not merely the general-purpose computer or microprocessor but, rather, the computer or processor programmed to perform the disclosed algorithm. *See WMS Gaming*, 184 F.3d at 1348-51; *In re Alappat*, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 *(Fed. Cir. 1994) (en banc)*. The identification of the disclosed algorithm is an essential part of determining the proper scope of such claim elements. *See id.*

The district court's claim construction, however, decoupled the means-plus-function element from the recited function and disclosed structure. It expanded the scope of the "image transform processor means" element to cover any software (regardless of algorithm) that results in a perspective corrected view. A finding of equivalence was permitted without requiring any evidence regarding the algorithms used to perform the functions at issue.

This approach, affirmed by the Federal Circuit, improperly relieves the patentee of the burden of showing structural equivalence separate and apart from functional equivalence. Patentees are therefore allowed to bypass the structural equivalents analysis of §112(6).

If this decision stands, patentees of functionally-claimed inventions will be able to gain an advantage

by admitting the absence of literal infringement and asserting infringement under the doctrine of equivalents, despite substantial differences in the structures used to perform a disputed function.

C. The Decision Below Eviscerates the Requirement to Consider Claim Elements in the Context of the Claim as a Whole

This Court has admonished that the

> analysis of the role played by each element in the context of the specific patent claim [should] inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element.

Warner-Jenkinson, 520 U.S. at 40. The Federal Circuit holding in this case, however, permits claim elements to be rewritten in isolation, without regard to the context of the claim as a whole. This is not only contrary to the instructions of this Court in *Warner-Jenkinson*, it is further inconsistent with the Federal Circuit's own opinions. *See, e.g., Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc.*, 141 F.3d 1084, 1090, 46 USPQ2d 1257 (Fed. Cir. 1998).

Respondent's infringement theory rested on the isolated replacement of the "digitized [fisheye] signals" claim limitation with the phrase "equirectangular panorama signals."[8] As a result of this substitution,

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[8] Respondent's trial exhibit PX – 336 recharacterized the image transform processor means element as follows:

> image transform processor means for processing **said equirectangular panorama signals** in said input image memory means according to selected viewing angles and magnification, and
>
> for producing output transform calculation signals according to a combination of said **equirectangular**

however, the claim element was dismembered, being left without any connection to the claim as a whole.

A proper effort to fit the rewritten element in the context of the apparatus claim as a whole would have resulted in significant functional and structural changes, including a very different transform means and an additional memory means.[9] This discontinuity

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panorama signals, said selected viewing angles and said selected magnification;

[9] A claim rewritten with support for the substituted element would have had to look as follows (in relevant part):

1. A device . . . which comprises:

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input image memory means for receiving said digitized fisheye signals;

first image transform means for processing all of said digitized fisheye signals in said input image memory means and for producing first output transform calculation signals to create equirectangular panorama signals;

intermediate memory means for receiving said equirectangular panorama signals;

second image transform processor means for processing ~~said digitized signals~~ said equirectangular panorama signals in said ~~input~~ intermediate image memory means according to selected viewing angles and magnification, and for producing second output transform calculation signals according to a combination of ~~said digitized signals~~ said equirectangular panorama signals, said selected viewing angles and said selected magnification;

output image memory means for receiving said second output signals from said image transform processor means;

input means for selecting said viewing angles and magnification;

microprocessor means for receiving said selected viewing angles and magnification from said input means and for converting said selected

is not simply linguistic, it is very real in terms of the operative apparatus. Referring to Plaintiff's Exhibit PX – 308 (Pet. App. 56a), entirely new components must be added to make a working system that uses the equirectangular panorama signals.

Permitting such an arbitrary substitution in a functional claim element would render it impossible to ascertain the scope of the claim prior to litigation. This introduces an element of uncertainty into the interpretation of patent claims beyond even that deemed unacceptable in *Halliburton*.

D. The Decision Below Allows Application of the Doctrine of Equivalents to Entirely Vitiate a Required Function of the Claim.

Pennwalt appears to be the only *en banc* decision of the Federal Circuit dealing with infringement under doctrine of equivalents where there is no infringement under §112(6). In *Pennwalt*, the Federal Circuit made clear that the doctrine of equivalents "does not mean one can ignore claim limitations." *Id.* at 935. It held that, where a recited function is completely missing from the accused device, there could be no infringement either literally or under the doctrine of equivalents. *See id.* No infringement was found because the claim language required that the "position indicating means" be responsive to a specified combination of signals that was not used in the accused system. *Id.* at 938.

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viewing angles and magnification for input to said second image transform processor means to control said processing of said second transform processor means; and

output means connected to said output image memory means for recording said perspective corrected view according to said selected viewing angles and magnification.

This case surreptitiously repudiates the *Pennwalt* holding on a strikingly similar set of facts.[10] In this case, the "image transform processor means," as claimed, requires transformation "according to a combination of said digitized [fisheye] signals, said selected viewing angles and said selected magnification." The '667 patent, claim 1. The function supplied by the claimed transform processor means thereby provides for the direct transformation of only a selected portion of an image from a fisheye lens for perspective-corrected magnified viewing. *See* The '667 patent, FIGS. 2 and 3, col. 2, lines 48-54.

As acknowledged in the Respondent's exhibits, the accused device does not use this claimed combination of signals. *See* PX – 308 at Pet. App. 56a. In Petitioner's product, rather, the entire fisheye image must first be converted into an equirectangular image using a first transform independently of any selected view and magnification. This form of image must then be stored in an intermediate memory. Only then can a second transform be used, along with a viewing area selection and magnification, to produce the perspective-corrected image. *See id.*

As in *Pennwalt*, therefore, the accused device in this case lacks a means operative in response to the specified (and claimed) combination of signals. By permitting a finding of infringement, the lower courts permitted the function of direct transformation "according to the combination" to be vitiated in its entirety.

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[10] The Federal Circuit panel did not even address Petitioner's arguments based on *Pennwalt* and the "all elements" rule.

CONCLUSION

The Court should declare the doctrine of equivalents inapplicable to §112(6) elements. It runs afoul of the statutory limits on functional claiming, ignores the built-in equivalents of §112(6) and enlarges the scope of functionally-claimed elements to the unpredictable extreme condemned by this Court in *Halliburton*. Nonetheless, if applicable, the Court must enunciate standards to ensure that the application of the judicial doctrine is not untethered from the statutorily-mandated construction requirements.

If this precedent remains in place, it will permit courts to veer from the statutory construction path of §112(6) and fall into a claim construction approach that swallows any structure supplying supposed functional equivalence. Patentees can be expected as a matter of course to admit a lack of literal infringement and to assert functional claim elements solely under the doctrine of equivalents in order to short-circuit the statutory strictures of §112(6).

Accordingly, the Court should grant this petition for a writ of certiorari.

Respectfully submitted,

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